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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,228	04/02/2001	Hirofumi Nakayasu	010273	6723
38834	7590	11/30/2005	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			DIVINE, LUCAS	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/822,228

Applicant(s)

NAKAYASU ET AL.

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1 – 20 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 9/9/05 have been fully considered but they are not persuasive.

With respect to applicant's arguments on page 11 that 'Tanaka does not disclose or suggest a printer that performs a printout when a client who has sent the print request instructs the printout at the printing agent printer site'.

In reply, the system of Tanaka includes service stations 3 that perform a various services for the users of the system. Each of these stations 3 has printers (see Fig. 1), thus being able to provide printing services. In fact, if the user needed specific printing done with specific options (staple, fast printing etc...) the service center keeps a database on the printers to help select the best/closest/chosen one for the user (see database info in Fig. 3 as examples). Details of printing items out is further discussed in col. 4 lines 52-57.

Also, as recited in the rejection, Tanaka clearly teaches the client can specifically instruct the printing of a printout at the specified service station (agent site) in col. 6 lines 46-51.

So not only is a specific example of the new limitation discussed, but based on having printing at the service stations and the stations offering 'various services' (col. 3 line 2), it would have also been obvious to one of ordinary skill in the art that one of the various services could

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have been specifically printing. Thus, the obviousness 35 U.S.C. § 103(a) rejection is explained and maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 4 and 10 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6522971) in view of Britt et al. (US 6647267) hereafter as Tanaka and Britt.

Regarding claim 10, Tanaka teaches **a printing agent service system** (Fig 1),  
**comprising:**

**a database** (Fig. 2 shows the databases located at the central service center that has information on the sites in the system, col. 3 lines 24-30) **for storing printing agent printer sites** (sites 3, Fig. 1); **and**

**a server** (service center 2; col. 3 lines 2-6) **for receiving a print request** (col. 1 lines 26 and 62, col. 3 lines 36-45, wherein printing is based on a user request, col. 4 lines 52-57 and 64, col. 6 line 47, wherein printed output is generated based on user print request) **and location information from a client terminal** (col. 4 lines 36-37 and 9-10), **and retrieving, from said database** (col. 4 lines 33-40), **the printing agent printer site nearest to the location of said client terminal in accordance with said location information** (Figs. 11A and 11B show the

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closest requested services to a user after it has been determined based on the user location; col. 8 lines 13-22),

**wherein said database further comprises at least one database of information on mobile communication device base stations** (Fig. 3 shows the database having information about the access points nearest a site, col. 3 lines 35-36), **addresses** (Fig. 3, in order to generated map data [col. 6 lines 33-37 and col. 3 line 48] the location of the user and the service station [col. 6 line 52 details the server knowing where the service station is] must be known, location data could be stored in service station information J7),

**said location information from the client terminal comprises at least one kind of information selected from mobile communications device base stations, zip codes, addresses, and telephone numbers** (col. 5 lines 40-42, wherein a user inputs a address for itself – col. 6 line 19 teaches a user being able to input a place of departure – col. 8 lines 63-64 teach the user being able to be set by the user as a starting point – col. 3 lines 60-63, col. 8 lines 3-5, col. 4 lines 8-9, col. 2 lines 6-7),

**said server sends said nearest printing agent printer site to said client terminal for display** (Figs. 11A and 11B, col. 8 lines 14-22), **and thereafter, receives from said client terminal a specified printing agent printer site** (col. 8 lines 31-32), **and sends print information of said print request to a printer at said specified printing agent printer site** (col. 4 lines 52-57, where a type of service that is used is printing and specifically line 52, where the data is sent from the server to the station – also col. 6 lines 48-52), **and**

**said printer performs a printout when a client who has sent said print request instructs said printout at said printing agent printer site** (col. 6 lines 46-51, wherein the user

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instructs the printing at the service station [printing agent site] and printing is performed – further, based on having printing at the service stations and the stations offering ‘various services’ [col. 3 line 2], it would have also been obvious to one of ordinary skill in the art that one of the various services could have been specifically printing).

While Tanaka teaches a database for storing locations of users and service stations and generating map data for guiding the user to the station, Tanaka does not specifically teach the database location information to be the addresses and corresponding longitudes and latitudes.

Britt teaches a mobile communication system (Fig. 1) including a mobile device 12 and a server 24 including a database 22 that perform similar location functions as the system of Tanaka including identifying database information on road conditions for traveling as well as other travel information that is stored in both the database of Britt (col. 2 lines 32-34) and Tanaka (Fig. 3, J2, J1, J3). Britt further teaches the database to take user location information and use databases that correspond longitudes and latitudes to addresses to determine the locations of the user (col. 2 lines 27-44). Thus Britt teaches using addresses that correspond to longitudes and latitudes as location information for locations in a server database in a mobile computing system.

It would have been obvious to one of ordinary skill in the art that the location information for the sites and user in the database of Tanaka could have been addresses associated with addresses, longitudes and latitudes. The motivation for doing so would have been to find exact locations for the addresses with the longitude and latitude system of GPS. Maps like those of Tanaka generally use address information of streets and sites in order for a person to navigate. Thus, using address information would have also been obvious in order to provide the user with information on the destination that a user could understand (address information instead of the

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longitude/latitude coordinates). Further, Tanaka also teaches receiving the current location of the user's mobile device (col. 7 lines 23-26), thus it would have also been obvious to use GPS for this to determine exact location of the user.

Regarding claim 11, which depends from claim 10, Tanaka teaches **server sends map information showing said nearest printing agent printer site based on said location information** (col. 7 lines 1-3, see more description in col. 6 as well).

Regarding claim 12, which depends from claim 10, Britt teaches **server receives GPS information from said client terminal** (col. 2 line 30, Fig. 1).

Regarding claim 13, which depends from claim 10, Tanaka teaches **server retrieves the current location of said client terminal based on said location information** (col. 7 lines 24-25, wherein a current location is detected based on user location information, also col. 8 lines 3-4), **and thereafter, retrieves printing agent printer site nearest to said current location** (col. 8 lines 13-30).

Regarding claim 1, the structural elements of apparatus claim 10 perform all of the steps of method claim 1. Therefore, method claim 1 is rejected for the same reasons stated in the rejection of apparatus claim 10.

Regarding claim 2, which depends from claim 1, the structural elements of apparatus claim 11 perform all of the method steps of method claim 2. Claim 2 is therefore rejected for the same reasons as claim 11.

Regarding claim 3, which depends from claim 1, the structural elements of apparatus claim 12 perform all of the method steps of method claim 3. Claim 3 is therefore rejected for the same reasons as claim 12.

Regarding claim 4, which depends from claim 1, the structural elements of apparatus claim 13 perform all of the method steps of method claim 4. Claim 4 is therefore rejected for the same reasons as claim 13.

4. Claims 14 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Britt as applied to claims 10 and 1 above, and further in view of Minari (US 6809831).

Regarding claim 14, which depends from claim 10, while Tanaka teaches the outputting of a print job and letting the user know where the print job is outputted (col. 6 lines 50-53), the combination of Tanaka and Britt does not specifically teach sending the printing results to the client terminal.

Minari teaches sending printing results to a user (Fig. 8, wherein the print result is sent to the printer controller and from there to the user application at the host computer).

It would have been obvious to one of ordinary skill in the art that letting a user know the results of their print job would have been beneficial to system where the user notified where the print job is being output. The motivation for doing so would have been to only have the user travel to the site to pick up the job when the job has been output correctly and when the job has not been output correctly, notifying the user so they do not travel and waste time to retrieve a job that hasn't been output correctly.

Regarding claim 5, which depends from claim 1, the structural elements of apparatus claim 14 perform all of the method steps of method claim 5. Claim 5 is therefore rejected for the same reasons as claim 14.



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5. Claims 15 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Britt as applied to claims 10 and 1 above, and further in view of Fritsch (US 6247130).

Regarding claim 15, which depends from claim 10, the combination of Tanaka and Britt teach logging into the server system (Fig. 6, col. 5 lines 10-17 of Tanaka) with user information (registration code and password for example; col. 5 line 57) as well as teaching having the user history of the user stored at the server in the database (col. 5 lines 18-25) including services used in the past (col. 5 line 24).

The combination does not specifically teach that this history information including past used sites/services is sent to the client terminal.

Fritsch teaches sending past used sites/services to the client terminal for display (Fig. 2A & 2B; col. 6 lines 49-61).

It would have been obvious that the history stored in Tanaka would be useful to the user so they could see and access sites they have used before. The motivation for providing such history to the user would have been to allow the user to use services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry.

Regarding claim 6, which depends from claim 1, the structural elements of apparatus claim 15 perform all of the method steps of method claim 6. Claim 6 is therefore rejected for the same reasons as claim 15.

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6. Claims 16 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka, Britt, and Minari as applied to claims 10, 14, 5 and 1 above, and further in view of Kawai et al. (US 6404994) hereafter as Kawai.

Regarding claim 16, which depends from claim 14, while the combination of Tanaka, Britt and Minari teach fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this example printing services]) and notifying the user of printing results (Minari Fig. 8), the combination does not specifically teach how the user pays for the printing services including that the **server automatically debits a specified account for an agent printing fee**.

Kawai teaches **server** (copier 18 includes printing server functionality as shown in Fig. 4) **automatically debits a specified account for a printing fee** (col. 5 lines 15-20, wherein charging device automatically debits a prepaid card, which is the user account information).

It would have been obvious that the automatic payment system of Kawai could have been used to pay for the printing services specified in the combination. The motivation for doing so would have been to allow users quick and automatic debit of their accounts so they would not have to deal with a person (thus quicker) or pay in cash (thus easier). Further, Kawai teaches the charging system is typically at a store (col. 4 line 12) and the printing services rendered in the combination are taught as implement able in a store (see Tanaka Fig. 11A, wherein the stores have specific prices for services).

Regarding claim 7, which depends from claim 5, the structural elements of apparatus claim 16 perform all of the method steps of method claim 7. Claim 7 is therefore rejected for the same reasons as claim 16.

7. Claims 18 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Britt as applied to claims 10 and 1 above, and further in view of Hanzawa (US 5506661).

Regarding claim 18, which depends from claim 10, while the combination teaches fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this example printing services]), the combination does not specifically teach sending the client the fee in accordance with the printing results.

Hanzawa teaches that it is well known in the art to notify a user of the cost of printing once the printing has been completed (col. 1 lines 19-22, wherein the fee is calculated after printing, and col. 1 line 11, wherein it is displayed for a user).

It would have been obvious to one of ordinary skill in the art that a printing fee for the print job could have been calculated and sent to the user in the combined system. The motivation for notifying a user of the cost of a printed print job would have been to allow the user to have the proper payment for the print job when they arrived at the service station of Tanaka to pick up their print job.

Regarding claim 9, which depends from claim 1, the structural elements of apparatus claim 18 perform all of the method steps of method claim 9. Claim 9 is therefore rejected for the same reasons as claim 18.

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Fritsch.

Regarding claim 20, Tanaka teaches a **printing agent service system (Fig 1), comprising:**

**a database (Fig. 2 shows the databases located at the central service center that has information on the sites in the system, col. 3 lines 24-30) for storing printing agent printer sites (sites 3, Fig. 1); and**

**a server (service center 2; col. 3 lines 2-6) for receiving a print request (col. 1 lines 26 and 62, col. 3 lines 36-45, wherein printing is based on a user request, col. 4 lines 52-57 and 64, col. 6 line 47, wherein printed output is generated based on user print request) and location information from a client terminal (col. 4 lines 36-37 and 9-10), and retrieving, from said database (col. 4 lines 33-40), the printing agent printer site nearest to the location of said client terminal in accordance with said location information (Figs. 11A and 11B show the closest requested services to a user after it has been determined based on the user location; col. 8 lines 13-22),**

**wherein said server sends said nearest printing agent printer site to said client terminal for display (Figs. 11A and 11B, col. 8 lines 14-22), and thereafter, receives from said client terminal a specified printing agent printer site (col. 8 lines 31-32), and sends print information of said print request to a printer at said specified printing agent printer site (col. 4 lines 52-57, where a type of service that is used is printing and specifically line 52, where the data is sent from the server to the station – also col. 6 lines 48-52), and**

**wherein said printer performs a printout when a client who has sent said print request instructs said printout at said printing agent printer site (col. 6 lines 46-51, wherein the user instructs the printing at the service station [printing agent site] and printing is performed**

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– further, based on having printing at the service stations and the stations offering ‘various services’ [col. 3 line 2], it would have also been obvious to one of ordinary skill in the art that one of the various services could have been specifically printing).

While Tanaka teaches logging into the server system (Fig. 6, col. 5 lines 10-17 of Tanaka) with user information (registration code and password for example; col. 55 line 57) as well as teaching having the user history of the user stored at the server in the database (col. 5 lines 18-25) including services used in the past (col. 5 line 24), Tanaka does not specifically teach that this history information including past used sites/services is sent to the client terminal.

Fritsch teaches sending past used sites/services to the client terminal for display (Fig. 2A & 2B; col. 6 lines 49-61).

It would have been obvious that the history stored in Tanaka would be useful to the user so they could see and access sites they have used before. The motivation for providing such history to the user would have been to allow the user to use services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry.

Regarding claim 19, the structural elements of apparatus claim 20 perform all of the steps of method claim 19. Therefore, method claim 19 is rejected for the same reasons stated in the rejection of apparatus claim 20.

9. Claims 17 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Britt as applied to claims 1 and 10 above, and further in view of Satomi et al. (US 2004/0039641).

Regarding claim 17, which depends from claim 10, the combination of Tanaka and Britt do not specifically teach placing adds on printouts or giving discounts accordingly.

However, Satomi teaches printing that includes an advertisement to a printer in accordance with an advertisement-included printing specification and discounts a printing fee in accordance with the printing that includes an advertisement (abstract and Figs. 17, 29, 53-56, 70, 77, 79 and their descriptions – other pertinent sections of the reference should be also reviewed, given figures just examples).

It would have been obvious to one of ordinary skill in the art to be able to include advertisements in the printouts as done in Satomi in the system of Tanaka and Britt. A motivation for doing so would have been the clear motivation of reducing cost for the user and securing advertising space for marketers.

Regarding claim 8, the structural elements of apparatus claim 17 perform all of the steps of method claim 8. Therefore, method claim 8 is rejected for the same reasons stated in the rejection of apparatus claim 17.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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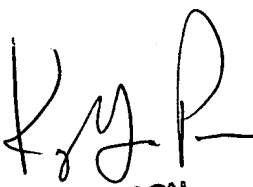
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ljd

  
**KING Y. POON**  
**PRIMARY EXAMINER**

Lucas Divine  
Examiner  
Art Unit 2624